



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,715	03/01/2002	Kathleen S. Keegan	27866/37081A/US	7406

4743 7590 09/05/2003

MARSHALL, GERSTEIN & BORUN LLP
6300 SEARS TOWER
233 S. WACKER DRIVE
CHICAGO, IL 60606

EXAMINER

PATEL, SUDHAKER B

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 09/05/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/087,715	KEEGAN ET AL.
Examiner	Sudhaker B. Patel, D.Sc.Tech.	Art Unit 1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 01 July 2002 .

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-30 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) _____ is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) 1-30 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s)
4) Interview Summary (PTO-413) Paper No(s). 6.
5) Notice of Informal Patent Application (PTO-152)
6) Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims (in part) 1-30, drawn to compounds, composition, a method of use for claim 1 generic Formula: " W-X1-C (=Y)-X2-Z, wherein W = 6-membered monocyclic heterocycle with 1,4-diazine ring = Pyrazine; Y = O or S; Z = Aryl or phenyl, classified in class 544, subclass 252.01.
 - II. Claims (in part) 1-30, drawn to compounds, composition, a method of use for claim 1 generic Formula: " W-X1-C (=Y)-X2-Z, wherein W = rings other than 1,4-diazine, and fused bicyclic rings not included in above Group I e.g. Quinoxaline, classified in class 514, subclass 183,242,256,266.1 and others depending on the meanings of W, X1, X2, Y, Z components. If this group is elected, further restriction/election will be required as there are many unknowns.

The inventions are distinct, each from the other because of the following reasons:

The compounds of Groups I-II are drawn to:

- (1). Structurally diverse compounds that are made and used independently of each other;
- (2). Compounds are separately classified and/or sub classified;
- (3). Classes/subclasses will require separate literature searches;
- (4). Compounds are not art recognized equivalents, and additionally,
- (5). The groups lack unity of invention (see MPEP 803.02).

Based on above stated data i.e. (1) - (5), claim 1 also lacks unity of invention.

2. Inventions I-II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for

using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case compounds of Sanchez et al (Science, Vol. 277, 1497-1501(1997)) and compounds of U.S.P. 6218109 can also be used for the utility as claimed herein.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
5. Claims 1,2,8,19, 30 are generic to a plurality of disclosed patentably distinct species comprising: -when W is aryl; -when W = pyridazine; -when W = Pyrimidine; - when W = pyrazine, and other heteroaryl or cycloalkyl rings together with Z component which can be simultaneously H or aryl or heterocyclyl, with or without substituents. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species from the working examples with all variables exactly and definitely disclosed, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. A telephone call was made to Mr. Napoli on 8/28/03 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

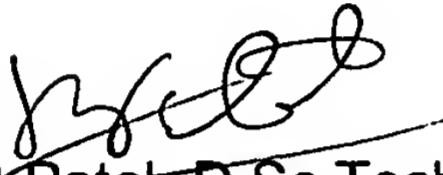
7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhaker B. Patel, D.Sc.Tech. whose telephone number is 703 308 4709. The examiner can normally be reached on 6:30 to 5:00 pm (Monday-Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund J. Shah can be reached on 703 308 4716 or Sr. Examiner Mr. Richard Raymond at (703) 308 4523.

The fax phone numbers for the organization where this application or proceeding is assigned are 703 308 4556 for regular communications and 703 308 4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1235.


Sudhaker B. Patel, D.Sc.Tech.
September 3, 2003.


MUKUND SHAH
SUPERVISORY PATENT
EXAMINER
ART UNIT 1624